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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,572	01/10/2002	Neil Miles	IPPM Case 7	7931

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FLYNN, THIEL, BOUTELL & TANIS, P.C.
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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/043,572	Applicant(s) MILES, NEIL	
	Examiner Susan B. McCormick	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: Notice to comply with sequence rules.

Art Unit: 1661

Detailed Action

The amendment of January 9, 2003 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action dated May 16, 2003.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 9, 2004 has been entered.

Sequencing

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132. **Applicants must comply with the sequence rules in order to effect a complete response to this Office action.**

Drawings

The disclosure is objected to under 37 CFR 1.165(b) because Applicant has not provided copies of the drawing in duplicate for figures 3 and 4 sent in on January 9, 2004. Correction is required.

Claim Rejections and Response to Arguments

Claim 1 remains rejected under 35 U.S.C. 112, first and second paragraphs, for the reasons stated in the last Office Action.

Applicant's amendment dated January 9, 2004, failed to address the following grounds for rejection. In addition is the response to arguments:

Applicant has included the recognized color chart used in the specification as pointed out on page 5 of the arguments. Applicant refers to a color chart reference in Table 1.

This is not persuasive as the color chart should be positively identified in the specification by reference to a designated color dictionary or color chart. It is not clear what color chart is used as Applicant does not refer to the

Art Unit: 1661

Royal Horticultural Society Colour Chart. Applicant should positively spell out correctly the color chart that is employed.

Applicant argues that the rejection, in comparing the parents, has no basis in law or fact, nor are there any guidelines cited by the Examiner that require such a comparison.

This is not persuasive as it is stated in the statute 37CFR 1.163 “*The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents....*” (emphasis added). Antecedent is defined as “one’s ancestors or ancestry” (Webster’s II New Riverside University Dictionary, 1994, page 111). Applicant is reminded that in prior office actions, the Examiner has cited this statute (paper no. 2, September 30, 2002). It is noted that Applicant has disclosed comparisons between other known cultivars sufficiently in this regard. What the Examiner is requesting is the botanical comparison between **the parents** of the claimed cultivar and the claimed cultivar as Applicant has not **disclosed any** botanical information about or pertaining to the parents.

Applicant argues that the requested information is in Table 1, section 2.1-2.3.

With respect to the information given, this does not sufficiently describe the height or spread of the claimed cultivar. As stated in the previous rejection, Examiner requested the height and spread be disclosed in quantitative measurements. Applicant has not disclosed such information. In section 2.3, Applicant is describing the habit of the tree, not height and spread.

Applicant argues that the information pertaining to vigor, height and spread is addressed in section 2.2 of Table 1 of the substitute specification. This is not persuasive as “Medium” is not a botanical characteristic for the term vigor and it does not describe the height and spread of the claimed tree.

Applicant states that the requested information on the trunk diameter is not available.

However, this type of information is found in virtually all peach patents and can be readily obtained with measuring device. Therefore, the request does not seem to be unreasonable.

Applicant argues the botanical description of the branch size (diameter), color and internode length are not distinguishing characteristics of the claimed variety.

This is not persuasive as stated in the response to the second argument, with reference to the MPEP, Applicant is directed to section 1605 of the MPEP where 37 CFR 1.163 is again pointed out. Applicant has not provided evidence as to why it’s not reasonably possible to provide this information.

Applicant argues that lenticel characteristics are not characteristics that distinguish the claimed variety from the closest reference variety.

Art Unit: 1661

This is not persuasive as Applicant is employing the wrong standards. The statute states “as complete as is reasonably possible.” Applicant has not provided evidence as to why it’s not reasonably possible.

Applicant states that the requested information (leaf shape, color, margin, texture, venation pattern, vein color, shape of the apex and base) is no longer applicable because the information is provided in the substitute specification.

With respect to the information given in section 3.1-3.13 in Table 1, Applicant has not disclosed the shape of the apex and base (i.e. acute, obtuse rounded) but discloses the **angle** of the base and tip. Applicant has not described the shape of the leaf (i.e. elliptic, ovate, oblong), nor the texture (i.e. smooth, pubescent) nor the color of the leaves (both surfaces with the employed color chart). In addition, the margin (i.e. serrate, dentate, crenulate) is not disclosed. A numerical scale is vague and is not a botanical description. Also the venation pattern, vein color and leaf arrangement is not disclosed.

Applicant states that the rejection is no longer applicable as the information requested is in the substitute specification.

With respect to the information given in section 3.10-3.13 in Table 1, a numerical scale does not describe the botanical characteristics of the petiole for the length, diameter and color. The botanical characteristics of the observed plant should be disclosed to differentiate between any other patented cultivars and Applicant has not disclosed a complete detailed botanical description of the observed plant.

Applicant argues that the rejection is no longer applicable as the information requested (shape, diameter, length and color of the flower bud) is provided in the substitute specification. In addition, **Applicant argues** there is nothing in 35 U.S.C. 112, 35 U.S.C. 161, 37 CFR rules or the MPEP that specific characteristics be utilized to identify and differentiate peach varieties.

This is not persuasive as the Examiner has stated in the above arguments that the botanical characteristics of the observed plant should be disclosed to differentiate between any other patented cultivars and Applicant has not disclosed a complete detailed botanical description of the flower bud as requested of the observed plant.

Applicant argues that the description of the sepals is not necessary to identify the claimed variety.

This is not persuasive as the information is found in virtually all plant patents and can be readily obtained with a color chart and measuring device. Therefore, the request does not seem to be unreasonable. There is no standard set of descriptions or characteristics required for peach or any other species. The botanical characteristics of the observed plant should be disclosed to differentiate between any other patented cultivars and Applicant has not disclosed a complete detailed botanical description of the observed plant.

Art Unit: 1661

Applicant argues that the rejection is no longer applicable as the information requested (flower diameter, petal size, shape, margin, color, texture, shape of the base and apex) is provided in the substitute specification.

With respect to sections 5.1 to 5.8 in Table 1, a numerical scale in describing the time of flowering and petal size, does not sufficiently describe these items. Applicant has not disclosed the length, width, margin, texture, shape, and shape of the apex and base of the petal.

Applicant argues that one skilled in the art of breeding peaches understands the difference between the various times of the growing season and can determine what is meant by “medium to late.”

This is not persuasive as there are various “growing seasons” throughout the United States and Canada. Interpretation takes on a different meaning for the recitation “medium to late”, referring to zones.

Applicant argues that the description of the reproductive organs is provided in Table 1.

With respect to Table 1, Applicant has not disclosed sufficient amount of information relating to the reproductive organs as the Examiner has requested.

Applicant states that the fruit characteristics are described in Table 1.

With respect to the information in sections 6.0 to 6.27 in Table 1, the information given in numerical scale does not sufficiently describe what the Examiner has requested.

Applicant states that the characteristic fruit weight has not been observed.

This is not acceptable as this is a relevant characteristic in describing any fruit and can be found in virtually all fruit patents. This is an important characteristic that would disclose if it's a small fruit or large fruit. Applicant is reminded of the statute 37CFR 1.163 “*The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties.*”

Applicant states that the information on the stone and kernel is provided in the substitute specification in sections 7.1 to 7.6 in Table 1. In addition, Applicant states that the color and shape of the stone are shown in Fig. 2 of the drawings.

With respect to sections 7.1-7.6, Applicant has failed to disclose information relevant to the stone and kernel of the observed plant. The color “red” should be disclosed according to the elected color chart. The size “medium” is vague and insufficient in this regard.

Applicant states that shipping long distance is not a factor due to the nature of processing of the fruit. Then Applicant should state that in the specification.

Applicant states the first and last pick of the fruit in the information provided in section 6.1 in Table 1.

Art Unit: 1661

With respect to the information given in Table 1, the term "late" is vague and insufficient in this regard.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Applicant's attention is drawn to "General Information About 35 U.S.C. 161 Plant Patents," available on the Internet at <http://www.uspto.gov/web/offices/pac/plant/index.html>. Under "The Examination" it is stated, in part:

If applicant's description is broad or brief, and such description falls within general descriptions of the species of claimed plant, this will form a *bona fide* basis of rejection. If major characteristics of the plant have not been botanically described, the disclosure will be objected to (and the claim rejected) by the examiner as incomplete with the reasoning of the examiner forming a basis for the objection/rejection.

Clearly, the Office expects Applicant to describe "major characteristics" of claimed plant, such as leaf and flower morphology. The General Information further states:

The description of the claimed plant will be compared with the closest available prior art. Prior art constitutes plants known and available to the skilled artisan at the time of Applicant's invention. If the disclosure of the application does not distinguish the claimed plant over such previously known and available plants (either patented or not patented) the claim will be rejected as failing to distinguish the claimed plant over the known plant. A plant patent or published botanical description of the prior art plant will be cited to establish the existence of the referenced plant. Should such a rejection be extended, it becomes incumbent on the Applicant to amend the disclosure to include further botanical description of the claimed plant that distinguish over known plant, if such is possible. Alternatively, or in addition, the Applicant may argue how and why the originally filed disclosure factually distinguishes the inventive plant over the plant of the reference.

With respect to the numerical scale as disclosed in Table 1, Applicant states that since relative values are disclosed, one skilled in the art can determine the necessary information. This is not persuasive as the botanical characteristics of the observed plant should be disclosed to differentiate between any other patented cultivars and Applicant has not disclosed a complete detailed botanical description of the observed plant.

There is no standard set of descriptions or characteristics required for peach or any other species. Enclosed are two recent peach tree patents provided as examples. See attached references cited, Howard and Zaiger *et al.* It is noted that Applicant is not being required to use the cited patents as a template for the description of his plant but as a guide as to what is requested in a plant patent application.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced and objection to the drawings.

Art Unit: 1661

Summary

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm


ANNE MARIE GRUNBERG
PRIMARY EXAMINER

Application No.: 10/043572

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: _____

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

For PatentIn software help, call (703) 308-6856

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE